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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/816,420	04/01/2004	Shirley B. Koffroth	SBK03	8855

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Mrs. Shirley B. Koffroth
1342 Jaguar Court
Palmdale, CA 93551

EXAMINER

ROANE, AARON F

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 08/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/816,420

Applicant(s)

KOFFROTH, SHIRLEY B.

Examiner

Aaron Roane

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 April 2005.
2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1 and 2 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Priority

The examiner fully acknowledges the claimed priority to the U.S. provisional application 60/499,930 filed 9/4/2003.

Response to Amendment

The response filed 4/11/2005 is acknowledged and addressed by this office action.

The supplemental reply filed on 6/24/2005 was not entered because supplemental replies are not entered as a matter of right except as provided in 37 CFR 1.111(a)(2)(ii). The supplemental reply is clearly not limited to placement of the application in condition for allowance. The proposed claim amendments do not place the case in condition for allowance nor do they even overcome the prior art of record.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1 and 2 are rejected under 35 U.S.C. 102(e) as being anticipated by Plewes (USPN 6,656,210 B1).

Regarding claims 1 and 2, Plewes discloses a thermal device comprising a strip of flexible material (14), said strip having a body contacting side (18) and an opposite outwardly facing side (side opposite 18 on which 30 is located) and an upper edge (edge adjacent and parallel to the short portion 28 shown in figure 3) and lower edge (edge opposite upper edge and edge adjacent and parallel to the short portion 30 shown in

figure 3); pocket-like receptacles (16) secured to the innermost body contacting side of the thermal device for the placement of frozen-flexible ice bags type blue or treated ice; a connecting means (the combination of 28 and 30 that comprise 22) to secure the upper and lower edges of the belt together and hold the belt in folded condition with the pocket-like receptacles inside the fold and the strip of flexible material to the outside thereof, see col. 3-4 and figures 1-3. Plewes fails to disclose that the strip of flexible material of sufficient length and width to gird a wearer's waist from the midriff down. However, Plewes does disclose "the main wrapping member 12 comprises a plurality of shapes and sizes for the purpose of utilization of one of the main wrapping members 12 on a particular body part such as an elbow, knee or other similar area. As to a further discussion of the manner of usage and operation of the present invention, the same should be apparent from the above description. Accordingly, no further discussion relating to the manner of usage and operation will be provided. With respect to the above description then, it is to be realized that the optimum dimensional relationships for the parts of the invention, to include variations in size, materials, shape, form, function and manner of operation, assembly and use, are deemed readily apparent and obvious to one skilled in the art, and all equivalent relationships to those illustrated in the drawings and described in the specification are intended to be encompassed by the present invention," see col. 4, lines 12-29.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Plewes (USPN 6,656,210 B1) in view of Horning (USPN 6,582,383).

Regarding claim 1, Plewes discloses a thermal device comprising a strip of flexible material (14), said strip having a body contacting side (18) and an opposite outwardly facing side (side opposite 18 on which 30 is located) and an upper edge (edge adjacent and parallel to the short portion 28 shown in figure 3) and lower edge (edge opposite upper edge and edge adjacent and parallel to the short portion 30 shown in figure 3); pocket-like receptacles (16) secured to the innermost body contacting side of the thermal device for the placement of frozen-flexible ice bags type blue or treated ice; a connecting means (the combination of 28 and 30 that comprise 22) to secure the upper and lower edges of the belt together and hold the belt in folded condition with the pocket-like receptacles inside the fold and the strip of flexible material to the outside thereof, see col. 3-4 and figures 1-3. Plewes fails to disclose that the strip of flexible material of sufficient length and width to gird a wearer's waist from the midriff down. However,

Plewes does disclose "the main wrapping member 12 comprises a plurality of shapes and sizes for the purpose of utilization of one of the main wrapping members 12 on a particular body part such as an elbow, knee or other similar area. As to a further discussion of the manner of usage and operation of the present invention, the same should be apparent from the above description. Accordingly, no further discussion relating to the manner of usage and operation will be provided. With respect to the above description then, it is to be realized that the optimum dimensional relationships for the parts of the invention, to include variations in size, materials, shape, form, function and manner of operation, assembly and use, are deemed readily apparent and obvious to one skilled in the art, and all equivalent relationships to those illustrated in the drawings and described in the specification are intended to be encompassed by the present invention," see col. 4, lines 12-29. In view of the lack of explicit recitation that the device of Plewes can, should and is used around the patient's waist, a further reference is provided to show that it would be obvious to combine the references to meet the claimed invention.

Horning discloses a bandage for application of therapeutic cold or heat treatments to injuries and teaches that the device can and should be configured in many different sizes and shapes in order to fit/conform to many different areas of one or more persons' bodies including the waist, see col. 1-8 and figures 1a-8. Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art to modify the invention of Plewes, as is well known in the art and taught by Horning, to configure the device in many different sizes and shapes in order to fit/conform to many different areas of one or more persons' bodies including the waist in order to apply thermal treatment to that area.

Regarding claim 2, Plewes discloses the claimed invention except for fastening means on the inner side of the upper portion of the pocket-like receptacles; thus securing the ice bags from falling out, and facilitating the removal of the ice bags at intervals for refreezing when the ice melts; depending on the temperature, body functions, and outer garment of the user while wearing the device. Horning teaches placing fastening means (18) located on the inner side of the upper portion of the pocket-like receptacles in order to removably secure the thermal agent (heat retention or cold retention material) inside the pocket, see col. 2-8 and figures 1a-8, particularly figure 3. Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art modify the invention of Plewes, as taught by Horning, to provide fastening means on the inner side of the upper portion of the pocket-like receptacles in order to removably secure the thermal agent (heat retention or cold retention material) inside the pocket.

Response to Arguments

Applicant's arguments filed 4/11/2005 have been fully considered but they are not persuasive.

The examiner will now address each argument/remark in turn.

Regarding STATEMENT 1 (see page 1, last line) of the response, the examiner acknowledges the priority of the presently claimed invention (please note the distinction between “the presently claimed invention” and a patent), claiming priority the U.S. provisional application 60/499,930 filed 9/4/2003. Although the acknowledgement was not explicitly stated in the initial office action, the effective date of 9/4/2003 was considered when searching for prior art. Regarding NOTE 1 (see page 2, line 12), Applicant is confusing the priority date requirements for prior art under (35 U.S.C.) 102(b) and 102(e). Note the rejection is under 35 U.S.C. 102(e) and the cited references have valid dates under 35 U.S.C. 102(e) and are therefore prior art.

Regarding STATEMENT 2, Note 2 (see beginning on page 3, line 7), Applicant asserts that Plewes incorrectly uses the term “thermal” when referring to the hot/cold pack. The examiner could not disagree more strongly and states emphatically for the record that the term “thermal” is used to indicate aspects relating to hot/cold temperatures, the transference of thermal energy and/or temperature gradients. Therefore, the examiner cannot grant Applicant’s request to regard all references of “cold” in Plewes as a contradiction. This particular point suggest s Applicant’s very narrow (and, quite frankly incorrect) interpretation of the field of invention.

Regarding Note 3 (see beginning on page 4, line 10), Applicant argues that Plewes fails to disclose that the strip of flexible material of sufficient length and width to gird the wearer’s waist from the midriff down. It should be pointed out that although Plewes does not explicitly recite particular further limitation, Plewes certainly implies/suggests a device having the recited

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further limitation. The examiner made this point very clear and cited passages within Plewes that support such implications (see 102 rejections above).

Next Applicant attacks Horning on the basis that it does not recite at least five elements that are part of the presently disclosed claimed invention. These elements/features are:

1) Plewes fails to disclose that the strip of flexible material is of sufficient length and width to gird a wearer's waist from the midriff down.

The examiner addresses this issue above with separate 102 and 103 rejections above.

2) Plewes fails to disclose that the pocket-like receptacles are for the placement of type blue or treated ice

The examiner disagrees with Applicant, and points out that the pocket-like receptacles of Plewes are more than capable of performing the recited intended use. It is particularly interesting that Applicant fails to acknowledge that the pocket-like receptacles of Plewes and the presently claimed invention are used for the same purpose, holding thermal agents such as ice.

3) Plewes fails to disclose that the connecting means of his wrap consist of an ample length of Velcro.

Again the examiner cannot disagree more strongly. Plewes discloses an ample length of Velcro-like or more specifically hook-loop type fasteners 28 and 30. Additionally, it should be pointed out to Applicant, that nowhere in the claims is the term hook-loop type fasteners or an equivalent used. Although operational characteristics of an apparatus may be apparent from the specification, we will not read such characteristics into the claims when they cannot be fairly connected to the structure recited in the claims. See In re Self, 671 F.2d 1344, 1348, 213 USPQ 1, 5 (CCPA 1982).

4) Plewes fails to disclose that said connecting means are an external element sewn to the wrap's extremities.

The recitation of said connecting means are an external element(s) sewn to the wrap's extremities does not exist in the claim language. Additionally, that fact that the fasteners maybe sewn to the wrap is irrelevant as it is a method of manufacture and does not distinguish the final product of the claimed invention over the prior art.

5) Plewes fails to disclose that the pocket-like receptacles contain fastening means on the inner side of the upper portion of said pockets.

The combination of Plewes and Horning clearly meet the further limitation of the pocket-like receptacles contain fastening means on the inner side of the upper portion of said pockets in order to retain the thermal agent placed within the pocket-like receptacles.

Regarding Note 4 (see beginning on page 5, line 14), Applicant argues that Plewes fails to disclose a connecting means are an external element sewn to the wrap's extremities, the examiner directs Applicant to the response to Note 3, #4 above and suggests that Applicant is interpreting the claimed invention and prior art much more narrowly than the examiner.

Although operational characteristics of an apparatus may be apparent from the specification, we will not read such characteristics into the claims when they cannot be fairly connected to the structure recited in the claims. See *In re Self*, 671 F.2d 1344, 1348, 213 USPQ 1, 5 (CCPA 1982).

Next in STATEMENT 3 (beginning on the last line of page 6), Applicant argues: “for sake of continued argument, we furthermore contend that the examiner's initial showing did not produce a prima facie case of unpatentable subject matter anticipated by Plewes on the grounds that anticipation is established only when the prior art element performs the identical function specified in the claim in substantially the same way, and produces substantially the same results as the corresponding element disclosed in the claimed invention,” see page 7, lines 1-6. It should be pointed out to Applicant, that Applicant is arguing intended use of the claimed apparatus, and whether or not the prior art explicitly disclosed “identical function” and substantially the “same result” is irrelevant when addressing apparatus claims. First it is important that Applicant as well as any other acknowledge that the presently claimed invention and its intended use as defined by the claims are anticipated by the prior art. Secondly, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Next, Note 5 (beginning on page 7, line 7) Applicant returns to the issue of use of the term “thermal” and its relation to hot/cold in the prior art. The examiner has addressed this point above. Suffice it to say, the examiner completely disagrees with Applicant and refers Applicant to any general text on physics and/or thermodynamics. Applicant is also arguing an intended use, and as noted above, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Regarding STATEMENT 4 (see beginning on page 9, line 13) Applicant asserts that “Plewes drawings do not exhibit all the claimed structural features and how they are put together.” The examiner disagrees and points out that as defined, the presently claimed invention as defined by the claim language is met by the prior art as broadly interpreted using the ordinary meanings of the words within the claims.

Next pages 11-17 provide information regarding the background and general use of the device. These pages do not present any arguments/remarks to which the examiner needs reply.

Next on page 18 of the reply filed 4/11/2005, it should be noted that Applicant numbers this page as Part 2, page 1. However, herein after, the page number will commence with page 1 of part 2 being page 18. Here in STATEMENT 1 and Note 1 (second time appearing) Applicant presents a duplicate of the remarks in STATEMENT 1 and Note 1 presently earlier and the examiner directs Applicant to the comments made above in regard to these issues.

Next, in STATEMENT 2 (see beginning page 19, line 12) Applicant asserts “there is no motivating force of sufficient weight provided by the examiner which would impel one skilled in

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the ad to do what the patent applicant is claimed to have done; thus justifying the combination of references.” Firstly, the two references are related by the fact they are both used to transfer thermal energy (heat/cold) from the devices therein described to or from a patient/person.

Secondly, that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. In re Keller, 642 F. 2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In this regard, a conclusion of obviousness may be based on common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference. In re Bozek, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969).

Next, Applicant argues the use of the term “thermal” again. The examiner directs Applicant the comments made above regarding “thermal” and/or “hot/cold”.

Next, Note 3 summarizes Plewes invention, its intended and its “spirit and scope.” Applicant argues that Plewes invention is different in scope and spirit from the presently claimed invention. This is extremely unpersuasive as it does not address structural distinctions if any of the presently claimed apparatus invention and the prior art.

Next regarding STATEMENT 3, Note 4 and STATEMENT 4, the examiner directs Applicant to the above remarks by the examiner regarding the combination of references and the test of an obviousness rejection.

Next in Note 5, the Applicant asserts that the examiner gives “impression that convincing evidence will hence forth be provided to substantiate the combination of Horning's reference

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with Plewes, the examiner initiates by mentioning Plewes failure to disclose that the strip of flexible material is of sufficient length and width to gird a wearer's waist from the midriff down." Next, "the examiner fills the page with the quote from Plewes, but does not give a convincing argument as to why one skilled in the art would be impelled to create Koffroth's invention given the prior art, nor an objective reason why Plewes teachings justify a combination of references pursuant the issue at hand." In response, the examiner pointed out that although Plewes was absent of an explicit recitation of sufficient length and width to gird a waist, the particular passage quoted in full by the examiner lends support/evidence that Plewes implies/suggest that the device may be suited for the waist. In addition to the 102 rejection of anticipation the examiner has provided a further rejection using Plewes as the primary reference and a secondary teaching reference of Horning that makes explicit to use of a device of sufficient length and width to gird the waist of the patient/person.

Next on page 24, Applicant asserts that the examiner has used hindsight in constructing rejections, see lines 9-19. In regards to Applicant's assertion that the examiner has used "hindsight" reconstruction, it should be noted "[a]ny judgement on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made and does not include knowledge gleaned only from applicant's disclosure, such a reconstruction is proper." In re McLaughlin 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971). Applicants may also argue that the combination of two or more references is "hindsight" because "express" motivation to combine the references is lacking. However, there is no requirement that an "express, written motivation to combine must appear in prior art

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references before a finding of obviousness." See *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 1276, 69 USPQ2d 1686, 1690 (Fed. Cir. 2004). For example, motivation to combine prior art references may exist in the nature of the problem to be solved (*Ruiz* at 1276, 69 USPQ2d at 1690) or the knowledge of one of ordinary skill in the art (*National Steel Car v. Canadian Pacific Railway Ltd.*, 357 F.3d 1319, 1338, 69 USPQ2d 1641, 1656 (Fed. Cir. 2004)). See MPEP § 2143.01 for a discussion of proper motivation to combine references.

Next regarding STATEMENT 5, the examiner can only disagree with Applicant and point to the above comments in full.

Next, STATEMENT 6 is yet another rehashing of Applicant aversion to Plewes use of "thermal". Please see all and any above comments directed to the use of "thermal."

In Note 7, Applicant yet once again (and incorrectly as far as the art is concerned) argues the use of "thermal" by Plewes. Again the examiner directs Applicant to all and any above comments directed to the use of "thermal."

Applicant next concludes with "CONCLUSION PART 2."

Finally, the examiner would like to point out that Applicant has repeatedly and unpersuasively argued against 1) the use of the term "thermal" by Plewes, 2) the combination of the prior art of record and 3) that each and every element of the presently claimed invention have not been disclosed by the prior art. The examiner has addressed these three points (and others) repeatedly. Additionally, the examiner has not and will not enter the supplemental amendment filed 6/24/2005.

In order to further assist Applicant, the examiner would like to point out that he is available for consultation via phone in order to explain the office's/examiner's position and the

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art in general and prior art of record. Additionally, there are several avenues open to Applicant at this point in the prosecution that Applicant may wish to discuss with the examiner.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron Roane whose telephone number is (571) 272-4771. The examiner can normally be reached on Monday-Thursday 7AM-6PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A.R. *A.R.*
August 8, 2005

Roy D. Gibson
ROY D. GIBSON
PRIMARY EXAMINER